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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/537,274
Filing Date: May 28, 2005
Appellant(s): BOGATYREV, ALEXEI BORISOVICH

John D. Gugliotta
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 January 2008 appealing from the Office action mailed 31 May 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on 29 October 2007 has not been entered.

The amendment after final rejection filed on 29 January 2008 has been entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

A substantially correct copy of appealed claims 2-11 appears on pages 9 and 10 of the Appendix to the appellant's brief. The minor errors are as follows: in claim 2, line

1, "1" should be --3-- as the dependency of claim 2 was changed from claim 1 to claim 3 in the amendment filed 3 March 2007.

(8) Evidence Relied Upon

US 3,186,333	Hoffman et al.	6-1965
US 3,448,557	Swaithes	6-1969

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- Claims 3-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman et al. **(US 3,186,333)**.

Regarding claim 3, the Hoffman et al. reference discloses a device for packaging articles including: a body (30); a container (38) for packing material (bands 11); a means for feeding (14-17) the packing material (11); and an element (36) for arranging the articles. The recitation in the preamble regarding "banding stacks of bank notes" is not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the

claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hira, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The recitation regarding “stacks of bank notes” in the claim is afforded little patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). In any event, the Hoffman et al. reference is fully capable of banding stacks of bank notes.

Regarding claim 4, the Hoffman reference discloses that the packing material is band rings (11) stacked (12) in a flattened condition (see figs. 2 and 10).

Regarding claim 5, the Hoffman reference discloses that the means for feeding comprises a pick-up unit (fingers 14-17) and a mechanism (77-80 - see col. 8) for displacement of the pick-up unit.

Regarding claim 6, the Hoffman reference has a guide tube (36) which is fully capable of deforming the article depending on the size of the article, and which is fully capable of deforming a stack of bank notes along a longitudinal axis of the bank notes.

Regarding claim 7, the Hoffman reference discloses that a position sensor (a pressure sensitive switch, photoelectric cell, or the like) may be actuated by the article entering the device (col. 10, lines 55-62).

Regarding claims 8 and 9, the Hoffman reference discloses that the element (36) for arranging the articles is coupled (they are mounted on the same machine body 30)

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to the displacement mechanism (77-80) and the pick-up unit (14-17), and that the container (38) is also mounted to the body (30). The language “in such a way ... “ (lines 3 and 4 of claim 9) is functional and fully capable of being performed by the Hoffman device.

- Claims 2, 3 and 5-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Swaithes (**US 3,448,557**).

Regarding claim 3, the Swaithes reference discloses a device for packaging articles including: a body (20); a container (40) for packing material (bags 41); a means for feeding (130 - see figs. 3 and 4); and an element (76) for arranging the articles. The recitation in the preamble regarding “banding stacks of bank notes” is not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hira, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The recitation regarding “stacks of bank notes” in the claim is afforded little patentable weight because it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Regarding claim 2, the Swaites reference discloses that the element for arranging the articles comprises a tubular casing (defined by fingers 76) which converges from an inlet to an outlet, and has a side cut out along its full length (the “side” may be read as either the top side or the bottom side in Swaites).

Regarding claim 5, the Swaites reference discloses that the means for feeding comprises a pick-up unit (131, 132, 133) and a mechanism (138, 140 - see col. 5, lines 56-71) for displacement of the pick-up unit.

Regarding claim 6, the Swaites reference discloses that the element (76) for arranging the articles deforms the articles along the longitudinal axis (see figs. 8-11).

Regarding claim 7, the Swaites reference discloses a number of position sensors (116, 117, 118, 120 and 121) for defining the position of the article.

Regarding claims 8 and 9, the Swaites reference discloses that the element (76) for arranging the articles is coupled (they are mounted on the same machine body 20) to the displacement mechanism and the pick-up unit, and that the container (40) is also mounted to the body (20). The language “in such a way ... “ (lines 3 and 4 of claim 9) is functional and capable of being performed by the Swaites device.

Regarding claim 10 and 11, the language of each claim is functional and a statement of intended use of the claimed device; the language of each claim fails to structural distinguish itself from the Swaites device. In any event, the functional language of claims 10 and 11 is fully capable of being performed by the Swaites device.

(10) Response to Argument

The 35 USC 102(b) rejection of claims 3-9 as anticipated by Hoffman et al.

Firstly, it is pointed out that the subject matter of claim 3 includes one limitation that has been presumed by the examiner as invoking 35 USC 112, 6th paragraph because the limitation “means for feeding said packing material” meets the “three-prong test” laid out in MPEP 2181. The examiner does not challenge appellant’s analysis found at page 5 of the brief as to what structure disclosed in appellant’s specification is construed to be covered by the limitation. The examiner does point out that the specification does not expressly set forth any exclusions in the specification for an equivalence to the structure construed to cover the limitation written in means plus function format. MPEP 2183 discusses making a prima facie case of equivalence, and relevant sections are reproduced below:

“If the examiner finds that a prior art element

- (A) performs the function specified in the claim,
- (B) is not excluded by any explicit definition provided in the specification for an equivalent, and
- (C) is an equivalent of the means- (or step-) plus-function limitation,

the examiner should provide an explanation and rationale in the Office action as to why the prior art element is an equivalent.”

In the present case, the examiner stated in the rejection of claim 3 (see Final Office action, mailed 31 May 2007, paragraph 7 on page 4 of the action) that the “means for feeding said packing material” is read in Hoffman et al. as “means for feeding (14-17) the packing material (11)”. This is considered to be an equivalent based on the guidance found in MPEP 2183 because the structure in Hoffman et al.

performs the identical function specified in the claim in substantially the same way, and produces substantially the same results as the corresponding element disclosed in the specification. Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 54 USPQ2d 1308 (Fed. Cir. 2000). Further, the prior art element in Hoffman et al. is a structural equivalent of the corresponding element disclosed in the specification. In re Bond, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). That is, the prior art element performs the function specified in the claim in substantially the same manner as the function is performed by the corresponding element described in the specification.

Accordingly, following the guidance set forth in MPEP 2183, the “burden then shifts to applicant to show that the element shown in the prior art is not an equivalent of the structure, material or acts disclosed in the application. In re Mulder, 716 F.2d 1542, 219 USPQ 189 (Fed. Cir. 1983). No further analysis of equivalents is required of the examiner until applicant disagrees with the examiner’s conclusion, and provides reasons why the prior art element should not be considered an equivalent. See also, In re Walter, 618 F.2d 758, 768, 205 USPQ 397, 407-08 (CCPA 1980) ... and In re Fitzgerald, 619 F.2d 67, 205 USPQ 594 (CCPA 1980) (a case indicating that the burden of proof can be shifted to the applicant to show that the subject matter of the prior art does not possess the characteristic relied on whether the rejection is based on inherency under 35 U.S.C. 102 or obviousness under 35 U.S.C. 103). See MPEP § 2184 when determining whether the applicant has successfully met the burden of proving that the prior art element is not equivalent to the structure, material or acts described in the applicant’s specification.”

The examiner having set forth in the Final Office action rejection that the “means for feeding said packing material” limitation found in claim 3 was read as “means for feeding (14-17) the packing material (11)” in Hoffman et al., appropriately shifted the burden to the appellant to show that the element shown in the prior art is not an equivalent of the structure disclosed in the application. The examiner points out that the record, without question, reflects that appellant has at no time during the prosecution of this application challenged the examiner's statement that the structure (recited in the rejection) found in the Hoffman et al. reference is an equivalent to the disclosed structure construed to cover the claim limitation “means for feeding said packing material”.

Secondly, addressing the specific arguments set forth in the brief, the appellant argues (page 6, 3rd paragraph) that the Hoffman et al. reference fails to teach each and every element of claim 3. Appellant contends that the element to arrange is not taught by Hoffman et al. This is flatly wrong, in the opinion of the examiner. The examiner has pointed out in the Hoffman et al. reference the element for arranging is the element (36), which is a funnel guide. It is without question that the funnel guide 36 is an element for arranging the article which is inserted therethrough for banding by the machine.

The appellant argues (page 6, 3rd paragraph) that the Hoffman et al. includes an automatic or a conveyor means to feed (an article) into a central opening where it is to be wrapped, and that Hoffman et al. teaches a device to sequentially separate rubber bands so that they can be individually snapped around an article. In response to appellant's argument, it is pointed out that if a reference is properly “prior art,” it is only

necessary that the claim(s) under consideration “read on” something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or “fully met” by it. Kalman v. Kimberly-Clark Corp., 218 USPQ 781. Anticipation under 35 USC 102 is established when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Systems, Inc., 221 USPQ 385. The mere fact that the Hoffman et al. reference discloses and teaches additional elements included in the machine does not properly refute the fact that each and every element of the claim is found in the Hoffman et al. reference. Claim 3 is properly rejected under 35 USC 102 (b) as anticipated by Hoffman et al.

The appellant argues (page 6, 4th paragraph) that the examiner argues that the element to arrange a stack of bank notes is given no weight because it is in the preamble. This is factually wrong as the examiner has made no such statement or advanced such an argument. The attention of the Board and appellant is directed to the examiner’s relevant rejection found above, as well as in the Final Office action dated 31 May 2007. The examiner has not ignored the limitation of the element for arranging (the appellant uses the expression element to arrange, which is not found in the claim) as alleged by appellant, as is clearly set forth in the relevant rejection above.

The appellant argues (page 6, 5th paragraph and over to page 7) that the Hoffman et al. reference does not teach a container having a box-like structure, and therefore the Hoffman et al. reference cannot anticipate claim 3. Once again, this argument is factually wrong. The feed chute (38) of Hoffman et al. is clearly and without

question a container (it contains the bands) and it is clearly and without question a box-like structure (it has a box-like shape - and a box can be curved in shape and vertically oriented). The appellant argues that the feed chute of Hoffman et al. has a generally oval outline to conform to the cross sectional configuration of the tubular assemblies, and because it is a chute it cannot be considered a container, and that it teaches away from a box-like container. The examiner disagrees with appellant because the claim requires a container, and the Hoffman et al. chute 38 contains the bands 12. Therefore the Hoffman et al. reference anticipates the limitation of a container. Further, the examiner disagrees with appellant because the claim requires the container have a box-like structure, and the Hoffman et al. chute 38 is clearly box-like in shape and structure.

Accordingly, the examiner has properly pointed out in the rejection and in the above response to appellant's arguments why the Hoffman et al. reference meets each and every limitation of claim 3, and therefore the rejection of claim 3 under 35 USC 102(b) as anticipated by Hoffman et al. should be affirmed.

The appellant argues (page 7, 1st full paragraph) with regard to claim 4 that the packing material in Hoffman et al. (rubber bands 12) are not stacked in a flattened position. As such, appellant argues that this limitation of claim 4 is not anticipated by the Hoffman et al. reference. The examiner disagrees with appellant's characterization of the rubber bands 12 shown in figure 2 of the Hoffman et al. reference. It is without question that the Hoffman et al. rubber bands are stacked one atop the other, and as is clearly seen in figure 2, the rubber bands have a flattened shape. Therefore the

rejection of claim 4 under 35 USC 102(b) as anticipated by Hoffman et al. should be affirmed as each and every limitation of the claim is met by the Hoffman et al. reference.

The appellant argues (page 7, 2nd and 3rd full paragraphs) that the dependent claims 5-9 further limit and incorporate the earlier limitations of independent claim 3, and since claim 3 is allegedly allowable, claims 5-9 should also be allowable. In response to appellant's argument, the examiner points out that such fails to argue the merits of the subject matter of claims 5-9 individually and to point out any supposed error in the rejection of claims 5-9. The rejection of dependent claims 5-9 under 35 USC 102(b) as anticipated by Hoffman et al. should be affirmed as appellant has failed to convince the examiner that the rejection of claim 3 is in error, and to point out any specific error in the rejection of the dependent claims 5-9. It is the examiner's opinion that if the rejection of claim 3 is affirmed that the rejection of claims 5-9 would also be affirmed because there is no specific argument pointing out a supposed error in the rejection of claims 5-9.

The 35 USC 102(b) rejection of claims 2, 3 and 5-11 as anticipated by Swaithe

Firstly, along the same lines as set forth above with regard to the rejection under 35 USC 102(b) using Hoffman et al., the examiner having set forth in the Final Office action rejection that the "means for feeding said packing material" limitation found in claim 3 was read as "means for feeding (130 - see figs. 3 and 4)" in Swaithe, appropriately shifted the burden to the appellant to show that the element shown in the prior art is not an equivalent of the structure disclosed in the application. The examiner points out that the record, without question, reflects that appellant has at no time during

the prosecution of this application challenged the examiner's statement that the structure (recited in the rejection) found in the Swaithes reference is an equivalent to the disclosed structure construed to cover the claim limitation "means for feeding said packing material".

Secondly, addressing the specific arguments set forth in the brief, the appellant argues (paragraph bridging pages 7 and 8) that the Swaithes reference cannot anticipate claim 3 because the element 76 cited by the examiner as the element to arrange articles is not an element to feed an article (i.e. banking notes, a garment, etc.), but is rather an element to feed packing material. In response to appellant's argument that the references fail to show certain features of the invention, it is noted that the features upon which applicant relies (i.e., an element to feed an article) are not recited in the rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). If appellant's argument is construed to mean that the element (76) of Swaithes does not meet the limitation "an element for arranging" found in claim 3, then the examiner strongly disagrees with the appellant. The examiner has pointed out above in the relevant rejection how the element (76) of Swaithes is read as the limitation "an element for arranging", and while the element (76) of Swaithes may or may not have other functions based on interpretation of the Swaithes disclosure, it is incorrect to argue that the element (76) does not meet the limitation of "an element for arranging" because it does in fact arrange the article.

The appellant argues (1st full paragraph on page 8) that the Swaithe reference is in an entirely different field of endeavor than that of appellant's invention. This argument is without merit and arguing the field of endeavor is irrelevant as to issues of anticipation under 35 USC 102. Furthermore, the argument that the Swaithe reference does not disclose every limitation recited in claim 3, including the element to arrange a stack of articles is deemed to be without much merit because such an argument fails to specifically point out how the language of the claim distinguishes from the reference, and such an argument fails to rebut the statements made by the examiner in the rejection as to why the Swaithe reference teaches each and every limitation found in the claim. It amounts to no more than a mere allegation of patentability without specifically pointing out how the language of the claims patentably distinguishes them from the references.

The appellant does not comment or argue further as to why the dependent claims 2 and 5-11 should be allowable. In response to appellant's silence as to the dependent claims 2 and 5-11, it would seem appropriate for the rejection of dependent claims 2 and 5-11 under 35 USC 102(b) as anticipated by Swaithe to be affirmed as appellant has failed to convince the examiner that the rejection of claim 3 is in error, and to point out any specific error in the rejection of the dependent claims 2 and 5-11. It is the examiner's opinion that if the rejection of claim 3 is affirmed that the rejection of claims 2 and 5-11 also be affirmed because there is no specific argument pointing out a supposed error in the rejection of claims 2 and 5-11.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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